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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,267	09/29/2005	Valerie De La Poterie	05725.1445	4347
22852	7590	01/13/2011		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER VENKAT, JYOTHSNA A	
			ART UNIT	PAPER NUMBER
			1619	
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			01/13/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,267

Applicant(s)

DE LA POTERIE ET AL.

Examiner

JYOTHSNA A. VENKAT

Art Unit

1619

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 87-89, 91, 93-142, 144-153 and 155-176 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 87-89, 91, 93-142, 144-153 and 155-176 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/24/09

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Examiner of this application is changed from Tracey Simmons Willis to **Jyothsna Venkat**.

Receipt is acknowledged of amendment and IDS filed on 9/24/09. Claims 90, 92, 143, 154 and 182-189 have been cancelled/ as per applicants' amendment dated 9/24/09.

Election/Restrictions

Applicants' are notified that claim 177 drawn to "process claims" was inadvertently included in the lack of unity as part of group I. Note that group I is drawn to compositions. Claim 177 is not drawn to composition, instead it is drawn to process claims. Therefore claim 177 is part of group II and not part of group I. This inadvertent typographical error is regretted.

Status of claims

Claims 1-86 , 90, 92, 143, 154 and 182-189 are cancelled. Claims 177-189 are withdrawn from consideration as being drawn to non-elected subject matter (election with traverse dated 4/17/2009). Claims 87-89, 91, 93-142, 144-153 and 155-176 are currently examined in the application.

In view of the amendment, the 102 rejection and 103 rejections dated 6/24/09 is hereby withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 87-89, 91, 93-142, 144-153 and 155-176 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is written description rejection.

Actual reduction to practice and complete structure of compositions of mascara disclosed which teaches **composition having a dry matter or dry extract content of greater than or equal to 45% by weight are drawn to specific examples using block polymers of examples 1-4.**

The block polymers used in the compositions are:

Example 1 is drawn to block polymer. This polymer is

poly(isobornyl
acrylate/isobutyl methacrylate) first block with a Tg
of 80°C, a poly(2-ethylhexyl acrylate) second block
with a Tg of -70°C and an intermediate block which is
an isobornyl acrylate/isobutyl methacrylate/
2-ethylhexyl acrylate random polymer is obtained.

This polymer has a weight-average mass of
77 000 g/Mol and a number-average mass of 19 000, i.e.
a polydispersity index I of 4.05.

Example 2 is drawn to block polymer. This polymer is

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poly(isobornyl
acrylate/isobornyl methacrylate) first block with a Tg
of 110°C, a poly(2-ethylhexyl acrylate) second block
with a Tg of -70°C and an intermediate block which is
an isobornyl acrylate/isobornyl methacrylate/
2-ethylhexyl acrylate random polymer is obtained.

This polymer has a weight-average mass of
103 900 g/Mol and a number-average mass of 21 300, i.e.
a polydispersity index I of 4.89.

Example 3 is drawn to block polymer. This polymer is

poly(isobornyl
methacrylate/isobutyl methacrylate) first block with a
Tg of 95°C, a poly(isobutyl acrylate) second block with
a Tg of -20°C and an intermediate block which is an
isobornyl methacrylate/isobutyl methacrylate/isobutyl
acrylate random polymer is obtained.

This polymer has a weight-average mass of
106 700 g/Mol and a number-average mass of 20 800, i.e.
a polydispersity index I of 4.85.

Example 4 is drawn to block polymer. This polymer is:

a poly(isobornyl acrylate/isobutyl methacrylate) first block with a Tg of 75°C, a poly(isobutyl acrylate) second block with a Tg of ~20°C and an intermediate block which is an isobornyl acrylate/isobutyl methacrylate/isobutyl acrylate random polymer is obtained.

This polymer has a weight-average mass of 144 200 g/Mol and a number-average mass of 49 300, i.e. a polydispersity index I of 2.93.

Example 5 is drawn to block polymer. The polymer is :

poly(isobornyl acrylate/isobutyl methacrylate/2-ethylhexyl acrylate) first block with a Tg of 25°C, a poly(2-ethylhexyl acrylate) second block with a Tg of ~50°C and an intermediate block which is an isobornyl acrylate/isobutyl methacrylate/2-ethylhexyl acrylate random

Reduction to practice using block polymers are 4 block polymers in the mascara compositions. Example 5 was not used in any mascara compositions which satisfies the functional limitation of dry extract (emphasis added). In all these examples the **first block** is having Tg of greater than 40° C and the monomers are either isobutyl methacrylate and isobornyl methacrylate. In all the examples drawn to preparation of block polymers the **second block** has Tg of less than 20° C and the monomers are 2-ethylhexylacrylate, isobutyl acrylate. The intermediate segment has monomers, which are isobutyl methacrylate and isobornyl methacrylate and isobutyl acrylate and 2-ethylhexylmethacrylate.

Specification explicitly teaches that the mascara composition having block polymer of example 1 present as 10% in mascara compositions of examples 6-7 was too thick and there is no

dry extract. Only examples 9-10 with 25% of block polymer of example 1 have dry extract of greater than 45% by weight. Examples 9-10 are drawn to mascara compositions which have paraffin wax, beeswax, modified hectorite, propylene carbonate, rice starch and pigment. All these components are present with specific weight percentages.

Example 1 block polymers was used in example 12 drawn to mascara compositions. In this example the block polymers is present as 10% and the dry extract is greater than 45 % by weight but this composition has carnauba wax, bees wax, rice bran wax, modified hectorite, paraffin wax, talc and two film formers , which are vinyl acetate/allyl stearate copolymer and polyvinyl laurate. Compare examples 6-7 which uses the same block polymer of example 1 with example 12. In examples 6-7 the block polymer with 10 % by weight was too thick and the dry extract could not be measured, where as example 12 with same block polymer with 10% by weight percentage has dry extract of greater than 45 % by weight.

Examples 14-16 uses block polymers of examples 3, 4 and 1 respectively and the weight percent is 10%. In all these examples the dry extract is grater than 45 % by weight and all these examples have the ingredients, paraffin wax, carnauba wax, polyolefin wax, bees wax, siliconized candelillia wax, modified hectorite, three film formers, which are vinyl pyrrolidone/eicosene copolymer, vinyl acetate/allyl stearate copolymer and polyvinyl laurate ; polybutene, propylene carbonate, water, ethanol, black iron oxide and isododecane.

Independent claim 87 is drawn to:

A composition for coating keratin fibers, comprising a cosmetically acceptable organic liquid medium and at least one film-forming linear ethylenic block polymer, wherein the at least one film-forming ethylenic linear block polymer has a poly dispersity index of greater than or

equal to 2.5 and comprises at least one first block and at least one second block of different glass transition temperatures (T_g), wherein the at least one first and at least one second blocks are linked together via an intermediate segment comprising at least one constituent monomer of the at least one first block and at least one constituent monomer of the at least one second block wherein the at least one constituent monomer of the at least one first block differs from the at least one constituent monomer of the at least one second block, the intermediate segment is a random copolymer block, and the at least one first block of the polymer is chosen from:

- a) a block with a T_g of greater than or equal to 40 °C,
- b) a block with a T_g of less than or equal to 20 °C,
- c) a block with a T_g of between 20 and 40 °C, and

the at least one second block is chosen from a category a), b) or c) different from the at least one first block, **wherein the composition has a dry matter or dry extract content of greater than or equal to 45% by weight.**

Neither independent claim 87 nor any claims dependent on claim 87 recite the specific ingredients of mascara compositions reciting the specific first block and specific second block and specific intermediate segment along with other ingredients which satisfies the claimed functional limitation of dry extract greater than 45% by weight.

The specification provides no information regarding what other compositions would likely results in meeting the functional language requirement of dry extract greater than 45 % by weight using only the block polymer drawn to genus of claim 87 or (claims 88-101, 138-142 144-153 and 155-176) or using the **first block** having a) a block with a T_g of greater than or equal to 40 °C and present in amount ranging from 20-90% by weight or 50-70% by weight

(claims 102-108) **or** using the **first block** having a **block with a Tg of between 20 and 40 °C**, and present ranging from 10-85% or 50-70 % by weight (claims 115-120) **or** using the **second block** of with a Tg of less than or equal to 20 °C and present in an amount ranging from 5-75% by weight or 25-45 % by weight (claim 109-114) **or** using **second block** having Tg of greater than or equal to 40 °C (115 and 121-126) **or** second block having a Tg less than 20 °C (claims 127-132) or **block polymer wherein the first block or the second block or both blocks having additional monomer** (claims 132-137).

None of compositions claimed meet the written description provision of 35 USC § 112, first paragraph, other than specific examples using specific combination of block polymers and also specific ingredients.

One of ordinary skill in the art would have concluded that applicants' was not in the possession of the gens or subgenus drawn to compositions for coating the eyelashes meeting the functional language requirement using the genus of block polymers formed from monomers of first block with different Tg and monomers of second block with different Tg and monomers of intermediate segment only without any ingredients present in the compositions drawn to either independent claim 87 or the claims dependent on claim 87.

Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116.)

The skilled artisan cannot envision which compositions would possess the property described in claim 87 drawn to dry extract. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. The composition itself is required. See *Fiefs v. Revel*, 25 USPQ2d 1601, 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016. In *Fiddes v. Baird*, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence. Finally, *University of California v. Eli Lilly and Co.*, 43 USPQ2d 1398, 1404, 1405 held that: ...To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (" [T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.").

Therefore, only examples 9-10, 12 and 14-16 drawn to mascara compositions with specific block polymer and specific ingredients and all of them having specific weight percent shown to possess to required property of dry extract and none of the claims meet the written description provision of 35 USC § 112, first paragraph since the composition does not recite the specific ingredients and weight percent of the specific ingredients of examples 9-10, 12 and 14-16 using **specific block polymers**. Applicant is reminded that Vas-Cath makes clear that the written description provision of 35 USC § 112 is severable from its enablement provision. (See page 1115.).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 97, 111, 129, 133-137 and 142 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The expression "acrylates of formula... in which at least one hetero atom chosen from O, N, and S optionally intercalated" is without metes and bounds in claims 97, 111 and 129. Recourse to the specification does not describe these monomers. If applicants' disagree with the examiner, they are requested to point out support to the specification for description these acrylates which has at least one hetero atom ... intercalated.

The same is true for "methacrylates of formula... in which at least one hetero atom chosen from O, N, and S optionally intercalated" is without metes and bounds in claims 111, 129 and 135. Recourse to the specification does not describe these monomers. If applicants' disagree with the examiner, they are requested to point out support to the specification for description these acrylates which has at least one hetero atom ... intercalated.

Claim 133 is unclear as to applicants' intent at line 2. It appears that the connecting operator "or" is missing after the first block at line 2.

Claim 142 is not dependent on any claim. Appropriate correction is required.

Claim Rejections - 35 USC § 103

Claims 87-89, 91, 93-132, 139-142, 144-153 and 155-176 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent 6,410,005('005).

Patent '005 teaches AB block copolymer comprising a soft hydrophobic and a hard, hydrophilic blocks with two or more distinct glass transition temperatures, represented by Structures 1 and 2 (col.4, ll 44-65). Patent '005 further teaches that the copolymers may be delivered from aqueous or hydro alcoholic solutions, dispersions or emulsions. The copolymers may be water, water-ethanol, or water solvent mixtures by dispersing the copolymer in solvent and adjusting the pH with an organic or inorganic base (col. 13, ll 55-62) and incorporated into a hair formulations , skin protective films, mascara formulation and nail formulation (col.14,ll 22-32). All these formulations read on claimed method of coating keratin fibers.

Patent '005 at column 7, line 65 to column 9, line 2 teaches suitable hydrophobic monomer A and includes the various (meth)acrylates, expressed in the claims, and this includes claimed methyl methacrylate, which can be first block or second block claimed in the instant application and patent '005 at column 10, ll 1-56 teaches preferred hydrophilic monomer B, which include alkyl acryl amides claimed in the instant application and these amides belong to either first block or second block with varying Tg (claims 93-94, 97, 105,113, 121-123, 128-130). Patent'005 at col.13, ll 1-8 also specifically teaches using varying proportion of mixtures of A and B monomers so as to achieve the desired balance of the resultant block polymer properties (claims 107-108, 113-114 and 119-120).

Patent '005 also teaches a process of polymerizing a poly functional monomer X within the scope of the instant intermediate block constituent (column 4, structures 1 and 2) with a first ethylenically unsaturated monomer(s) to form an A block, and subsequently polymerizing a second ethylenically unsaturated monomer(s) containing at least one carboxylic acid group with the A block to form a B block, and the resultant block copolymer (col.3, ll 53-60; col. 4, ll18-43;

col. 5, ll 2- 4; col. 6, line 27 through column 7, line 57). Thus, a copolymer containing blocks of $-(B)p-X-(B)q-$, and $-(A)n-A-X-A-(A)n-$ is formed, wherein X is a multifunctional monomer that links A and B block. The linkage of X-X reads on the instant intermediate block, wherein X is also a constituent monomer of the A and B blocks in $-(B)p-X-(B)q-$, and $-(A)n-A-X-A-(A)n-$. Absent of specific compositional and architectural details defined for the instant intermediate block, prior art $-B-X-X-A-$ linkages in structures 1 and 2 fall within the scope of the instant intermediate block as both block A and B contains at least one constituent X, as defined in the present claims. Additionally, the weight percent of each of the monomers in the mixture can vary, depending on the desired properties if the final copolymer product. In one embodiment, 28 wt% to about 60 wt% of monomer A for A block and about 38 wt% to about 60 wt% of monomer B, for B block (col.13, ll1- 8). Patent '005 col.6, lines 3-5 teaches an average molecular weight of the resultant block copolymer of up to 1,000,000, having film forming property and water dispensability (claims 145-148). Patent '005 at col.14, ll, 8-10 teaches the solvent system comprising up to 25% by weight of an organic solvent (claim 149, and 159-163. See also table 7 and examples at col.28, line 35 through col.29, line 36). Patent '005 at col.14, ll 30-32 teaches examples of additives that are used in the formulation of hair, skin, and nail (keratin) include conditioning agents and present in an amount of from about 0.1% to about 10 % and at col.15, ll 15-33 teaches volatile hydrocarbons like PERMETHYL 99A and PERMETHYL 101A and also volatile silicone oil (claims 152-153 and 155). Patent at col.29, ll 12-25 teaches formulations, which are drawn to oil/in water and water/oil formulations and these formulations uses non-volatile oils like isopropyl palmitate +paraffin oil, soybean oil and mineral oil+ isopropyl palmitate + perhydrosqualene and the weight percents are 10%, 5.2% and 26% and

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these formulations are wax free (claims 156-158 and 167). Patent at col.28, ll 45-63 teaches formulations, which have wax and the weight percent of waxes are 3 % and 12.2% (claims 164-166). Patent '005 at col.18, ll 54-65 teaches hair fixatives can be incorporated. Hair fixatives are known in hair care art as film forming polymers (168). Patent '005 at col.14, ll 20-28 teaches that the formulation may further comprise formulation additives including fragrances, dyes and colorants, plasticizers, emulsifiers, UV absorbers, lubricants (claim 173). Additives can be present in the amount of 0.01-19% of the formulation (col. 18, ll 41-43). Patent '005

Patent '005 teaches the method and the selection of various monomers species in formation block copolymer systems having balance of hydrophilic/hydrophobic properties. The selection of hard and soft block components with differences in glass transition temperature is suggested within the scope of the present claims.

Regarding the functional limitation of dry matter content of greater than or equal to 45% by weight recited in claims 87, 150-151, 170-171 and 175-176, PTO is not equipped to measure the dry extract recited in instant claims by following the protocol described at pages 6-7.

Accordingly, it would have been obvious to one of ordinary skill in the art would have readily envisaged the selection of the suitable monomers having Tg differences as taught, motivated by the reasonable expectation of success in forming block copolymers with balanced hydrophilic/hydrophobic characteristics. Once the respective monomer block components are suggested with Tg consideration, the determination of their optimum proportions or workable ranges taught within the general disclosures of prior art, would involve only routine skill in the art. The reference is silent regarding the poly dispersity index expressed in the present claims, however poly dispersity is the ratio of the weight average molecular weight to the number

molecular weight the examiner is of the position that it would have been obvious and fully within the knowledge of one having ordinary skill in the art to control the optimum molecular weight, poly dispersity, polymer composition and architectures of the resultant block copolymer product by varying experimental parameters such as monomer, amount of monomer, solvent catalyst/initiators/control agents, polymerization temperature and time. This is a prima facie case of obviousness.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 87- 87-89, 91, 93-142, 144-153 and 155-176 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 77-80, 83-94, 97-107, and 109-161 of copending Application No. 10/529,266 or claims 80-83, 86, 87, 90-140, and 142-165 of copending Application No. 10/529218 or claims 65-136 of copending Application No. 10/529,698 or claims 108-112, 115, 11 6, 119-168, 170-181,187, 191,192, and 196-220 of copending Application No. 10/529,265. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the co-pending applications and instant application are claiming the same block film forming ethylenic block polymers of at least one film-forming linear ethylenic block polymer, wherein the at least one film- forming ethylenic linear block polymer has a polydispersity index of greater than or equal to 2.5 and comprises at least one first block and at least one second block of different glass transition temperatures (T_g), wherein the at least one first and at least one second blocks are linked together via an intermediate segment comprising at least one constituent monomer of the at least one first block and at least one constituent monomer of the at least one second block, wherein the at least one constituent monomer of the at least one first block differs from the at least one constituent monomer of the at least one second block, the intermediate segment is a random copolymer block, and the at least one first block of the polymer is chosen from: a) a

block with a Tg of greater than or equal to 40 °C, b) a block with a Tg of less than or equal to 20 °C, c) a block with a Tg of between 20 and 40 °C, and the at least one second block is chosen from a category a), b) or c) different from the at least one first block. The scope of the polymers that result from the above combination of the various blocks, based on their Tg, polydispersity and molecular weights in each of the above copending applications is similar to the scope of polymers in instant claims. Claims drawn to coating composition of keratin fibers claimed in instant application is a cosmetic composition claimed in all co-pending applications using the same film forming ethylenic block polymers.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 87- 87-89, 91, 93-142, 144-153 and 155-176 are directed to an invention not patentably distinct from claims 77-80, 83-94, 97-107, and 109-161 of copending Application No. 10/529,266 or claims 80-83, 86, 87, 90-140, and 142-165 of copending Application No. 10/529218 or claims 65-136 of copending Application No. 10/529,698 or claims 108-112, 115, 116, 119-168, 170-181, 187, 191, 192, and 196-220 of copending Application No. 10/529,265 of commonly assigned applications. Specifically, for the reasons set forth in the obviousness type double patenting rejection.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/529,266 ; 10/529218; 10/529,698 and 10/529,265 , discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting

inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WAX ROBERT can be reached on 571-272-0623. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1619